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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,484	05/21/2001	Horst Grafe	HM-390PCT	5641

7590
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New York, NY 10173

04/17/2007

EXAMINER

PRONE, JASON D

ART UNIT	PAPER NUMBER
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3724

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/17/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/744,484

Applicant(s)

GRAFE ET AL.

Examiner

Jason Prone

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☒ Claim(s) 6-8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 1, 2, and 6-8 are objected to because of the following informalities: In claim 1 lines 1-2, the phrase "A method for exchanging shears in the cutting to length of strips or sheet metal" should be replaced with "A method for moving shears in cutting strips or sheet metal". The term "exchanging" is not correct since the shears are never exchanged only moved. On line 5 of claim 1, the phrase "the strip" should be replaced with "the strip of sheet metal". On line 8 of claim 1, the phrase "with holding elements" should be replaced with "with the holding elements". On lines 20-21 of claim 1, the phrase "form-fit connected and frictionally connected" should be replaced with "form-fit/frictionally connected"

In claim 2 lines 1-2, the phrase "A method for exchanging shears in the cutting to length of strips or sheet metal" should be replaced with "A method for moving shears in cutting strips or sheet metal". The term "exchanging" is not correct since the shears are never exchanged only moved. On line 11, the phrase "on which frame" is not grammatically correct and should be replaced with "on the U-shaped frame" for consistency.

In claim 6 lines 1-2, the phrase "A method for exchanging shears in the cutting to length of strips or sheet metal" should be replaced with "A method for moving shears in cutting strips or sheet metal". The term "exchanging" is not correct since the shears are never exchanged only moved. On line 11, the phrase "on which frame" is not grammatically correct and should be replaced with "on the U-shaped frame" for

consistency. On lines 16-17 of claim 6, the phrase "at a free end of an upper horizontal frame arm" should be replaced with "at the open side of an upper, horizontal arm of the U-shape frame" for consistency. On lines 24-25 of claim 6, the phrase "form-fit coupling and frictionally coupling" should be replaced with "form-fit/ frictionally coupling".

In claim 7 lines 1-2, the phrase "A method for exchanging shears in the cutting to length of strips or sheet metal" should be replaced with "A method for moving shears in cutting strips or sheet metal". The term "exchanging" is not correct since the shears are never exchanged only moved. On line 10, the phrase "on which frame" is not grammatically correct and should be replaced with "on the U-shaped frame" for consistency. On lines 16-17 of claim 7, the phrase "at a free end of an upper horizontal frame arm" should be replaced with "at the open side of an upper, horizontal arm of the U-shape frame" for consistency.

In claim 8 lines 1-2, the phrase "A method for exchanging shears in the cutting to length of strips or sheet metal" should be replaced with "A method for moving shears in cutting strips or sheet metal". The term "exchanging" is not correct since the shears are never exchanged only moved. On line 10, the phrase "on which frame" is not grammatically correct and should be replaced with "on the U-shaped frame" for consistency. On lines 16-17 of claim 7, the phrase "to frame arms" should be replaced with "to two frame arms of the U-shaped frame" for consistency.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

On line 13, the phrase "opening a forward connection" is unclear. It is uncertain what structure makes up the connection (i.e. what two items are connected to form the forward connection). It is unclear what structure actually opens up. It is uncertain how or where this connection is opened. Do the blade holders detach from one set of holding elements or from the clamping plate? Also, on lines 20-21, the phrase "is form-fit/frictionally connected before a subsequent cut" is unclear. It is uncertain what structures are form-fit/frictionally connected to one another to allow for the connection to be opened or closed. The structural details of the forward connection must be added to the claim.

On lines 22-28 of claim 1, the movement of the part (2') of the rolling table is unclear. First, since the forward connection is not defined, it is unclear if the part of the rolling table is connected to the U-shaped frame. Does the movement of the shears also move the movable part of the rolling table? If this is the case it is unclear how opening the forward connection ever occurs. Does the movable part of the rolling table move independent but simultaneously with the U-shaped frame?

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-5 are rejected, as best understood, under 35 U.S.C. 102(b) as being anticipated by David (3,408,886).

In regards to claims 1 and 2, David discloses a device for exchanging shears (Figs. 3-5) in the cutting to length of strips on a rolling table (1), the shears (Column 3 lines 9-13 and 30,31) are arranged on a rail-guided (29) drive carriage (26) is movable by means of a drive transverse to the rolling line (Figs. 4 and 5), the shear comprise a U-shaped frame open toward the rolling line and closed at a drive side (Fig. 4), at the drive side holding elements (34,35) are provided that support the blade holders (30,31), and wherein the drive carriage is coupled to a movable part of the rolling table (Fig. 4).

In regards to claim 3, David discloses the drive carriage at the rolling table side receives at least one clamping element with actuating members (40).

In regards to claim 4, David discloses the u-shaped frame has a correlated therewith a clamping element (38) coupled with the holding element at the rolling table side (39).

In regards to claim 5, David discloses the clamping element (38) is provided with coupling elements (37) that couple with the holding elements of the frame arms (39).

Allowable Subject Matter

6. Claims 6-8 would be allowable if rewritten or amended to overcome the objection(s) set forth in this Office action.

Response to Arguments

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the shears are only introduced into the line when the strip needs to be separated transversely) are not recited in the rejected claim(s) especially the apparatus claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). David discloses a U-shaped frame that performs a cut, is moved to a neutral position, and then moved back to a working position to perform a subsequent cut. The claims do not recite any method steps stating how often the shears are moved to the neutral position. David clearly performs the method as claimed.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Prone whose telephone number is (571) 272-4513. The examiner can normally be reached on 7:00-4:30, Mon - (every other) Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on (571) 272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

April 13, 2007


Patent Examiner
Jason Prone
Art Unit 3724
T.C. 3700


BOYER D. ASHLEY
SUPERVISORY PATENT EXAMINER